

REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-4 and 6-13 are now pending. By this Amendment, claim 5 is canceled without prejudice or disclaimer, claims 1, 3, 4, 6, and 9 are amended, and new claims 10-13 are added. No new matter is added.

Summary of Rejections

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,712,535. A Terminal Disclaimer that should overcome this rejection is submitted herewith.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,677,927 to Bruck et al. (“Bruck”). Claims 1-4 are rejected as being anticipated by U.S. Patent No. 6,489,950 to Griffin et al. (“Griffin”). Claims 3-5, 8, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruck in view of Griffin. Claims 5, 8, and 9 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Griffin. Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Griffin in view of U.S. Patent No. 6,404,415 to Kim (“Kim”), and also as being unpatentable over Bruck in view of Griffin, and further in view of Kim.

Independent Claim 1

Independent claim 1 as amended recites a keyboard comprising a rotatable wheel wherein its width is greater than its diameter. Neither Bruck nor Griffin teaches or suggests such a rotatable wheel, and it is submitted that amended claim 1 is allowable over both references.

Independent Claim 3

Independent claim 3 as amended recites a keyboard comprising a rotatable wheel that has an outer diameter that is larger at a first side than a second side, the first side being more proximal to an alphanumeric section than the second side. Neither Bruck nor Griffin teaches or suggests such a rotatable wheel. Nor would any proposed combination of Bruck and Griffin result in such a rotatable wheel. Accordingly, it is submitted that amended claim 3 is allowable over Bruck and Griffin, either alone or in combination as proposed.

Rejection Alleging Routine Experimentation (Independent Claims 4 and 9)

Independent claim 4 is amended only to incorporate all of the features recited in now-canceled dependent claim 5, and recites a keyboard comprising a rotatable frustum-shaped member and at least one of a Cut key, a Copy key, and a Paste key located within 3 cm of the rotatable frustum-shaped member. Claim 9 is amended only to be rewritten as an independent claim including all of the features recited in original claims 4 and 8. As amended, independent claim 9 recites a keyboard comprising a rotatable frustum-shaped member, and further comprising an input element that provides a back command when actuated, wherein the input element is located 2.5 centimeters or less from the rotatable frustum-shaped member.

In rejecting both of these claims, the Office Action correctly notes that the asserted art does not teach or suggest the claimed inventions. Nevertheless, the Office Action baldly asserts, without any teaching in the art, that the claimed inventions would have been obvious through routine experimentation. Such an assertion has no legal basis.

The Office Action alleges that certain modifications to existing keyboards would have made the keyboards more comfortable. However, there is nothing in the *prior art* that suggested that the particularly claimed keyboard configurations would have been more comfortable. Nowhere in the prior art of record is it implied or stated that it would have been more comfortable, for example, to have a Cut key located within 3 cm of a rotatable frustum-shaped member (as recited in claim 4). Instead, the alleged level of comfort of the particularly claimed keyboard configuration is a hindsight conclusion that was apparently drawn by the Examiner after having benefited from Applicants' own disclosure. This is improper. As clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). Not only has the Office Action relied on such improper hindsight construction, it has done even worse; as noted in the Office Action, the pieces of the claimed inventions are not even taught by the prior art.

Moreover, the claimed inventions do not fall within the realm of what can be achieved through routine experimentation. There are literally an infinite number of ways to configure a keyboard. Keyboards have been around for decades, and presumably during that time manufacturers have been researching the best possible keyboard configurations. Despite such competition, there is no evidence that anyone else has recognized the benefits of a keyboard having, not just any keys, but at least one of a Cut key, a Copy key, and a Paste key, and not just located anywhere, but particularly located within 3 cm of a rotatable frustum-shaped member, as recited in claim 4. Similarly, there is no evidence that anyone else has recognized the benefits of a keyboard comprising a rotatable frustum-shaped member, and further comprising an input element that provides a back command when actuated, wherein the input element is located 2.5 centimeters or less from the rotatable frustum-shaped member, as recited in claim 9.

For at least these reasons, it is submitted that amended claims 4 and 9 are allowable.

Independent Claim 6

Claim 6 is amended only to be rewritten as an independent claim including all of the features recited in original claim 4. As amended, independent claim 6 recites a keyboard comprising a rotatable frustum-shaped member and a keyboard upper housing having a planar section and raised ridge, the rotatable frustum-shaped member located in the raised ridge. The Office Action attempts to piece together the claimed keyboard configuration by combining elements from the keyboards of Bruck, Griffin, and Kim. Regardless of whether the proposed combination is proper, the proposed combination still fails to have all of the features of claim 6. In particular, the Office Action relies on Kim to show a raised ridge and a rotatable wheel (handle 82). The Office Action asserts that the portion between elements 66 and 68 in Kim is a raised ridge. Whether or not this is true, it is irrelevant; the handle 82 (i.e., the alleged rotatable wheel) is not located in the portion between elements 66 and 68. Instead, the handle 82 is actually disposed in a *recess* 62. (Kim, Fig. 3C, col. 7, Ins. 27-34). A recess is simply not a raised ridge. Thus, the proposed combination of Bruck, Griffin, and Kim would, at best, include a handle disposed in a recess, not in a raised ridge. In contrast, an illustrative and non-limiting embodiment is described in Applicants' specification of a rotatable wheel 44 located in a raised

ridge 42. (Applicants' specification, Fig. 2, p. 9 ln. 22 to p. 10 ln. 1). For at least these reasons, it is submitted that claim 6 is allowable.

Dependent Claims

The remaining dependent claims, including the newly-added claims, are also allowable for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein.

Conclusion

All rejections having been addressed, it is submitted that the present application is in condition for allowance, and notice to that effect is respectfully requested. Should the Examiner have any questions or feel that an interview would expedite allowance, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

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Dated: October 12, 2004